

REMARKS

Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

Withdrawal of *Ex parte Quayle* Action

Applicants would like to thank the Examiner for withdrawing the *Quayle* action and reopening prosecution. Applicants believe that in view of the amendment offered in this response and the remarks made herein, the rejections should be withdrawn, and claims 32-34 should be rejoined.

Applicants note the Office's comment on page 2 of Paper No. 17, regarding *Elections/Restrictions*, that "Applicant's further election in Paper No. 13 with traverse of SEQ ID NO:91...is acknowledged." This statement is inaccurate, as SEQ ID NO:9, not SEQ ID NO:91, was elected with traverse for examination. Applicants respectfully request that the Examiner correct this error, for the record, in the next communication from the Office.

Amendments to the Claims

Claim 31 b) has been amended to clarify that which Applicants regard as their invention and not for reasons related to patentability. Claim 31 b) as amended recites "a polynucleotide completely complementary to the polynucleotide of a)" as suggested by the Examiner on page 4 of Paper No. 17. Support for this amendment can be found in the specification, e.g., page 7, lines 23-27. Applicants respectfully request entry of this amendment.

Rejoinder of Method Claims

Claims 32-34 are "method of use" claims of the product of claim 31 that cover the same scope of product as the product of claim 31 now under consideration. Therefore, it is submitted that upon allowance of any of the product claims, claims 32-34 should be rejoined and considered, in accordance with the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §

103(b)." Quoting the Commissioner:

....in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

Applicants respectfully bring to the Examiner's attention that claims 32-34 depend from product claim 31 and claims which depend therefrom. Therefore, rejoinder of claims 32-34 upon allowance of product claim 31 is proper and is respectfully requested.

Rejection under 35 U.S.C. §102 (b)

Claim 31 is rejected under 35 U.S.C. § 102 (b) because the recited polynucleotides are allegedly anticipated by Minekura et al. (Genomics 42:180-181 (1997)) (Office Action of October 20, 2003, page 5). The Office Action asserts that Minekura et al. teach "a nearly full length cDNA for human ACS3 which has a best local similarity score of greater than 99% identity to instantly disclosed SEQ ID NO:9 between position 272 and position 3164" and further that "Minekura et al. further teach a number of different human ACS3-specific primers that were used for the detection of the human ACS3 gene." (Office Action, October 20, 2003; page 5). This rejection is traversed for at least the following reason.

Applicants respectfully disagree with the Patent Office position that the ACS3 of Minekura et al. is more than 99% identical to SEQ ID NO:9 of the instant application. While the Minekura et al. ACS3 may have greater than 99% sequence identity to portions of SEQ ID NO:9, Applicants draw the Examiner's attention to the facts that SEQ ID NO:9 is 4027 base pairs in length while the ACS3 of Minekura et al. is 2905 base pairs in length (see, for example, Exhibit A). Minekura et al. do not teach 271 base pairs at the 5' end and 812 base pairs at the 3' end of SEQ ID NO:9. Thus, Minekura et al. do not teach each and every element and limitation of claim 31 of the instant application, because the entire sequence of SEQ ID NO:9 is not taught by Minekura et al. Therefore, the invention of claim 31 and the polynucleotide of SEQ ID NO:9 cannot be anticipated from the Minekura et al. ACS3, and withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §112, second paragraph, for indefiniteness

Claim 31 was rejected as indefinite for allegedly “failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention” and further that, “... it is vague and confusing in the recitation ‘a polynucleotide complementary to the polynucleotide of a)’ because it is unclear if it [sic] applicants intent to include polynucleotides that are merely partially complementary to the polynucleotide of a) as being encompassed by this recitation” (Office Action of October 20, 2003, pages 3-4). The Examiner continues that “it is unclear if applicants intend to include both those polynucleotides which are [sic] have merely partial complementarity as well as those polynucleotides which have ‘complete’ complementarity to the polynucleotide of a).” Applicants traverse this rejection.

Claim 31 b) has been amended to further clarify Applicants’ invention. Claim 31 b) as amended recites “a polynucleotide completely complementary to the polynucleotide of a),” that is, the polynucleotide sequence of SEQ ID NO:9. This amendment was suggested by the Examiner in order to advance prosecution and help applicants overcome this rejection (Office Action of October 20, 2003, page 4).

Thus, claim 31 as amended defines the patentable subject matter of SEQ ID NO:9 and its complementary sequences with a reasonable degree of precision and particularity. Withdrawal of this rejection is therefore requested.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding objections/rejections. Early notice to that effect is earnestly solicited.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

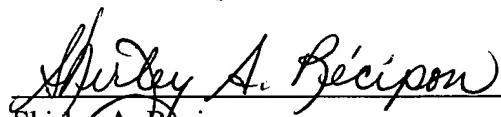
Respectfully submitted,

INCYTE CORPORATION

Date: 1-20-04


Sara Roza Greenwald
Reg. No. 55,225
Direct Dial Telephone: (650) 845-4691

Date: January 20, 2004


Shirley A. Recipon
Reg. No. 47,016
Direct Dial Telephone: (650) 621-8555

Customer No.: 27904
3160 Porter Drive
Palo Alto, California 94304
Phone: (650) 855-0555
Fax: (650) 849-8886

Attachment(s): Exhibit A: Sequence alignment, SEQ ID NO:9 to gi4165017 (Minekura et al. (1997) Genomics 42:180-181)